

REMARKS

Applicants have amended claims 1, 7, 8, and 9 as follows: including the limitations of claim 4 in claim 1, the limitations of claims 5 and 6 in claim 7, the limitations of claim 6 in claim 8, and the limitations of claim 5 in claim 9. Amended claims 1, 7, 8, and 9 have the same scope as original claims 4, 7, 8, and 9, respectively. Applicants have also cancelled claims 2-6, 11, and 16-33 and added new claims 34-48. Support for new claims 34, 37, 42, 46, 47, and 48 can be found in original claims 9, 10, 12, 13, 14, and 15, respectively. Support for the other new claims can be found in the specification; namely, claims 35 and 43 in paragraphs 0022 and 0039; claims 36 and 44 in paragraphs 0022, 0031, and 0039; claim 38 in paragraph 0034; claim 39 in paragraphs 0034 and 0035; claim 40 in paragraph 0023; claim 41 in paragraph 0036; and claim 45 in paragraphs 0038 and 0039. No new matter has been introduced by the above amendments.

Upon entry of the above amendments, claims 1, 7-10, 12-15, and 34-48 will be pending and under examination. Reconsideration of this application, as amended, is respectfully requested in view of the remarks below.

Rejections under 35 U.S.C. § 102(e)

Under 35 U.S.C. § 102(e), the Examiner rejects (1) claims 1, 2, 4, and 12, relying on Lamberton et al., U.S. Publication No. 2005-0084668 (Lamberton) and (2) claims 1, 2, 5-8, 11, 12, and 16, relying on Ejiri, U.S. Publication No. 2004-0115480 (Ejiri).

Applicants disagree and would like to bring to the Examiner's attention the following passage quoted from § 2136.03 of the Manual of Patent Examining Procedure, Eighth Edition:

35 U.S.C. 102(e) is explicitly limited to certain references "filed in the United States before the invention thereof by the applicant" (emphasis added). Foreign applications' filing dates that are claimed (via 35 U.S.C. 119(a) – (d), (f) or 365(a)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may not be used as 35 U.S.C. 102(e) dates for prior art purposes. This includes international filing dates claimed as foreign priority dates under 35 U.S.C. 365(a). Therefore, the foreign priority date of the reference under 35 U.S.C. 119(a)-(d) (f), and 365(a) cannot be used to antedate the application filing date. In contrast,

applicant may be able to overcome the 35 U.S.C. 102(e) rejection by proving he or she is entitled to his or her own 35 U.S.C. 119 priority date which is earlier than the reference's U.S. filing date.

As indicated above, the reference's foreign priority date under 35 U.S.C. § 119(a)-(d) and (f) cannot be used as the 35 U.S.C. § 102(e) reference date. So, the 102(e) reference date of Lamberton is its U.S. filing date of October 16, 2003 and the 102(e) reference date of Ejiri is its U.S. filing date of September 12, 2003. The present application claims priority under 35 U.S.C. § 119 to a Singapore application (200300519-6), which has a filing date of February 11, 2003. As the priority date of the present application predates the U.S. filing dates of Lamberton and Ejiri, the 102(e) rejection based on these two references should be withdrawn. See the last sentence in the above quotation.

Rejections under 35 U.S.C. § 102(a)

The Examiner rejects claims 1-3, 5, 6, 11, and 16 for anticipation, relying on Ryonai et. al., U.S. Patent No. 6,242,085 (Ryonai).

Claim 1, as amended, covers a method for forming a thin film magnetic recording medium. The method includes generating magnetic nanoclusters; heating the magnetic nanoclusters in gas phase to form crystals; and depositing the magnetic nanoclusters onto a substrate to form a thin film of magnetic particles. As mentioned above, amended claim 1 corresponds to original claim 4.

Ryonai discloses a method for forming a thin film magnetic recording medium. Nowhere in Ryonai is mentioned heating magnetic nanoclusters in gas phase to form crystals. Of note, the Examiner clearly agrees with this point, as he asserts that "Ryonai et al. does not teach heating a further heating step" (see the Office Action, page 3, line 18). By contrast, claim 1 requires heating magnetic nanoparticles in gas phase during crystallization. Thus, claim 1 is novel over Ryonai.

Applicants would like to point out that the Examiner does not reject original claim 4 relying on Ryonai. Clearly, it is the Examiner's position that original claim 4 is novel over

Ryaonai. As amended claim 1 has the same scope as original claim 4, it should also be the Examiner's position that claim 1, as amended, is novel over Ryonai.

Claims 7-10 and 12-15 depend from claim 1. For the same reasons set forth above, these claims are also novel over Ryonai.

Rejections under 35 U.S.C. § 103(a)

The Examiner rejects for obviousness (1) claims 3 and 17, relying on Lamberton; (2) claims 3, 13-15, and 17, relying on Ejiri; and (3) claim 17, relying on Ryonai.

Applicants would like to point out that the Examiner's reliance on Lamberton and Ejiri as 103(a) references is misplaced. As stated in MPEP 2141.01, "[a] 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date." As both Lamberton and Ejiri were filed in the U.S. after the priority date of the present application, they do not qualify as any 102 references. As a result, they also do not qualify as 103(a) references. Thus, the 103(a) rejection base on Lamberton or Ejiri should be removed.

Turning to the rejection of claim 17 based on Ryonai, Applicants have cancelled this claim in the sole interest of moving this application toward allowance.

New claims

New claims 34-48 have been added. Applicants would like to first discuss claim 34-41.

Claim 34 is an independent form of original claim 9. The Examiner acknowledges that original claim 9 "would be allowable if rewritten in independent form." See the Office Action, page 7, lines 1-3. Thus, claim 34 is in condition for allowance. For the same reasons, claims 35-41, dependent from claim 34, are also in condition for allowance. Of note, claim 37 corresponds to original claim 10, which, according to the Examiner, also covers allowable subject matter. See the Office Action, page 7, lines 1-3.

Applicants now turn to claims 42-48. Claim 42 is independent and has a scope identical to that of original claim 12. The Examiner rejects original claim 12 relying on Lamberton and

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Ejiri, but not Ryonai. As Lamberton and Ejiri have been removed as 102(e) or 103(a) references, this claim should be allowable in view of the cited art. Claims 43-48 depend from claim 42 and should also be allowed.

CONCLUSIONS


Applicants believe that the rejections asserted by the Examiner have been overcome and all pending claims are novel and unobvious over the cited prior art references. Applicants therefore respectfully request that all pending claims be allowed.

Please apply any charges to deposit account 06-1050, referencing Attorney's Docket No. 17184-002001.

Respectfully submitted,

Date: _____

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